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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,347

08/27/2003

Steven R. Reznick

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4170

7590

07/17/2007

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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1743

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/649,347

Applicant(s)

REZNEK ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) 44-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, drawn to a method for providing product consistency and controlling the particles, classified in class 436, subclass 8.
- II. Claims 44-53, drawn to methods of producing a carbonaceous material and the associated control, classified in class 428, subclass 402+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a carbonaceous material is not required and the steps of comparing and adjusting are not required. The subcombination has separate utility such as a method of controlling the production of a carbonaceous material.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such

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claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Newly submitted claims 44-53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: See the above analysis of the combination/subcombination of the claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The Examiner acknowledges receipt of the lengthy information disclosure statements filed 10/27/03;12/02/04;3/7/05 and 7/21/05. There is no requirement that applicants explain the materiality of English language references, however the cloaking of a clearly relevant reference in a long list of references may not comply with applicants' duty to disclose, see Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338. There is no duty for the Examiner to consider these references to a greater extent than those ordinarily looked at during a regular search by

the Examiner. Accordingly, the Examiner has considered these references in the same manner as references encountered during a normal search of Office search files.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of the claims are directed to "... providing product consistency..." and a method of "... controlling a process...". However, the bodies of the claims fail to teach any measuring steps where the consistency and control processes are preformed. For the purposes of examination, the claims are best understood as methods of measuring the claimed parameters and controlling the process to maintain the desired parameters.

These claims are also vague and indefinite what is intended by "interfacial potential". This value is not defined in the claims and one having ordinary skill in the art would not be able to determine the claimed interfacial potential value.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reszler (USP 5,974,167) cited by Applicants.

In light of the above 35 USC 112 second paragraph issues, the invention is best understood as a method of monitoring the quality of carbon black, a metal oxide or silica particles by measuring a parameter of the particle and comparing the measured parameter to a predetermined standard value.

Reszler teach in column 5 lines 40+ measuring physical parameters, such as particle size, of carbon black, metal oxides and silica particles. Column 4 lines 21+ teach a method of measuring the particle size and comparing the measured size to a predetermined standard value.

### ***Response to Arguments***

Applicant's arguments filed 4/30/07 have been fully considered but they are not persuasive.

Applicants traverses the 35 USC 112 second paragraph rejections stating one having ordinary skill in the art would understand the terms. Further, Applicants state they can be their own lexicographer and the terms in question are clearly described in the specification.

The Office has read the selection of the specification cited by Applicants and maintains these terms are not defined in a clear and unambiguous manner that would permit one having ordinary skill in the art to make and/or use the invention.

Applicants traverse the 35 USC 102(b) rejections stating the invention provides quality control and/or quality assurance for a particulate material and also makes it

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easier for a customer to obtain consistency of their products. These remarks are not commensurate in scope with the pending claims that do not reflect these features.

Applicants state Reszler "... does not relate at all to maintaining at least one interfacial potential property .... within a first target range". The Office maintains Reszler teach in column 5 lines 40+ measuring physical parameters, such as particle size, of carbon black, metal oxides and silica particles. Column 4 lines 21+ teach a method of measuring the particle size and comparing the measured size to a predetermined standard value which has been properly read on the instant claims.

Applicants state "... what ever quality control assurance protocols that Reszler is describing are merely those implemented at the end product level and not upstream particulate production level." Again these remarks are not commensurate in scope with the pending claims that have no limitations to "end product level" or "upstream particulate product".

Applicants state Reszler does not teach controlling any process steps. The instant claims are directed to "maintaining" which is not a control step.

Applicants state Reszler does not teach or recognize the problems of particles that are "within spec" but do not have the desired performance. The claims are directed to method of providing product consistency and these remarks are not commensurate in scope with the pending claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'Lyle A. Alexander', written in a cursive style.